

REMARKS

Claims 1, 2, 4-8, 10-14, 16-20, and 22-24 are currently pending in the application.

This amendment is in response to the final Office Action of February 21, 2008.

35 U.S.C. § 112 Claim Rejections

Claims 4, 12 and 18 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants have amended claims 4, 12, and 18 to comply with the provisions of 35 U.S.C. § 112, first paragraph.

Claims 4, 12 and 18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants have amended the claimed invention for the presently claimed invention to particularly point out and distinctly claim the subject matter of the invention to comply with the provisions of 35 U.S.C. § 112. Therefore, presently amended claims 4, 12, and 18 are allowable under the provisions of 35 U.S.C. § 112.

35 U.S.C. § 102(e) Anticipation Rejections

Anticipation Rejection Based on Sakaki et al. (U.S. Patent Publication No. 2003/0017652)

Claims 1, 2, 5-8, 10, 11, 13, 14, 16, 17, 19, 20 and 22-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Sakaki et al. (U.S. Patent Publication No. 2003/0017652).

Applicants assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Brothers v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants assert that the Sakai et al. reference does not and cannot anticipate the claimed inventions of presently amended independent claims 1, 7, 13, and 19 under 35 U.S.C. § 102 because the Sakai et al. reference does not identically describe, either expressly or inherently, each and every element of the claimed invention in as complete detail as is contained in the claim.

Turning to the cited prior art, the Sakai et al. reference describes a semiconductor chip 1 having a resin 7 on the surface thereof and having a resin film bonded to a back surface 1Y of the chip 1 wherein the resin film is a thermosetting resin of the epoxy group.

Applicants assert that the thermosetting resin of the epoxy group as a resin film of the Sakai et al. reference does not describe the elements of the claimed inventions of presently amended independent claims 1, 7, 13, and 19 calling for “a passivation layer covering a portion of the integrated circuit causing a stress on at least a portion of the semiconductor substrate, the passivation layer including silicon dioxide and silicon nitrides”, and a force-balancing layer covering at least a portion of the back side, the force-balancing layer for balancing a portion of the force on the front side, the force-balancing layer comprising at least one of a metal, a metal alloy, a metallorganic material, a photoresist material, a multilayer material remaining as a multilayer material having independent layers for balancing stresses omnidirectionally when balancing the tensile and compressive stresses of the semiconductor substrate, a multilayer tape material remaining as a multilayer material having independent layers for balancing stresses omnidirectionally, an adhesive material having reinforcement materials therein, a temporary adhesive material having reinforcing material therein, and a chemical vapor deposition material”.

Applicants assert that the resin 7 of the Sakai et al. reference is not silicon dioxide or silicon nitrides or thermosetting resin of the epoxy group as a resin film of the Sakai et al. reference does not describe a metal. Applicants assert that the thermosetting resin of the epoxy group as a resin film of the Sakai et al. reference does not describe a metal alloy. Applicants assert that the thermosetting resin of the epoxy group as a resin film of the Sakai et al. reference does not describe a metallorganic material. Applicants assert that the thermosetting resin of the epoxy group as a resin film of the Sakai et al. reference does not describe a multilayer material for balancing stresses omnidirectionally. Applicants assert that the thermosetting resin of the epoxy

group as a resin film of the Sakai et al. reference does not describe a multilayer tape material remaining as a multilayer material having independent layers for balancing stresses omnidirectionally. Applicants assert that the thermosetting resin of the epoxy group as a resin film of the Sakai et al. reference does not describe a multilayer tape material remaining as a multilayer material having independent layers for balancing stresses in a plurality of directions or omnidirectionally. Applicants assert that the thermosetting resin of the epoxy group as a resin film of the Sakai et al. reference does not describe an adhesive material having reinforcement materials therein. Applicants assert that the thermosetting resin of the epoxy group as a resin film of the Sakai et al. reference does not describe a temporary adhesive material having reinforcing material therein. Applicants assert that the thermosetting resin of the epoxy group as a resin film of the Sakai et al. reference does not describe a chemical vapor deposition material. Applicants assert that the thermosetting resin of the epoxy group as a resin film of the Sakai et al. reference does not describe an adhesive layer comprises a layer of markable material including one at least one of a UV acrylic, thio-phene material, poly-paraxylylene material, urethane material, silicone material and acrylic material for laser-marking.

Applicants assert that, at best, the Sakai et al. reference describes a resin on the surface of the device and a thermosetting resin of the epoxy group as a resin film which applied in layers are thermally hardened to convert the layers to a single layer of resin film. Applicants assert that such a description is not any of the claimed inventions of presently amended independent claims 1, 7, 13, and 19 whatsoever.

Therefore, presently amended independent claims 1, 7, 13, and 19 are allowable as well as the dependent claims therefrom.

Applicants submit that claims 1, 2, 4 through 8, 10 through 14, 16 through 20, and 22 through 24 are clearly allowable over the cited prior art.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Sakaki et al. (U.S. Patent Publication No. 2003/0017652)

Claims 4, 12 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaki et al. (U.S. Patent Publication No. 2003/0017652). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, the Examiner must determine whether there is “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Further, rejections on obviousness grounds “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id* at 1741, quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilsfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

Applicants assert that the Sakaki et al reference does not teach or suggest the claim limitations of either independent claims 1, 7, 13, and 19 under 35 U.S.C. § 103 or the claim limitations of dependent claims 4, 12, and 18 which is recognized in the Final Rejection. Further Applicants assert that any rejection of claims 4, 12, and 18 based on the Sakaki et al. reference is an impermissible hindsight reconstruction of the claimed inventions based solely upon Applicants’ disclosure as it is recognized the cited prior does not teach or suggest such claim limitations. Therefore, claims 4, 12, and 18 are allowable.

Applicants request entry of this amendment for the following reasons:

The amendment is timely filed.

The amendment places the application in condition for allowance.

The amendment does not require any further search or consideration.

Applicants submit that claims 1, 2, 4-8, 10-14, 16-20, and 22-24 are clearly allowable over the cited prior art.

Applicants request the entry of this amendment, the allowance of claims 1, 2, 4-8, 10-14, 16-20, and 22-24, and the case passed for issue.

Respectfully submitted,



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